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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/580,542	05/30/2000	Shigeyuki Kawai	SON-1844	1556

23353 7590 08/13/2002

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EXAMINER

FRANKLIN, JAMARA ALZAIDA

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 08/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/580,542

Applicant(s)

KAWAI ET AL.

Examiner

Jamara A. Franklin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgment is made of the receipt of the amendment received on 5/28/02. Claims 1-24 are currently pending.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 5-14, and 16-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Hogan (US 5,557,516).

Hogan teaches a financial card 100, with corresponding user bank account, for use for transactions with a sales/transaction terminal 307. The terminal 307 processes data (identification and financial) stored in a memory 201 of the card 100. Other data stored in the memory is last date and time of purchases (col. 5, lines 11-64). The balance on the card 100 is reduced to account for the price of the item purchased. If the balance on the card 100 is insufficient to cover the purchase price, and a maximum number of renewals has not been reached, an automatic renewal is triggered by the terminal 307 to increase the balance by \$25 (col. 6, lines 31-46). An issuer computer 303 periodically bills the card 100 user \$25 (col. 10, lines 34-38). A detailed statement is generated every month and sent as the card 100 user's regular credit card bill (col. 11, lines 59-61).

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3. Claims 20-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Tomoyuki et al. (US 5,991,747).

Tomoyuki teaches an IC card 1 for use with a POS terminal 8. The IC card 1 is inserted into a slot of the POS terminal 8. When it is verified that the IC card 1 has been inserted, it is checked to determine whether the owner of the IC card 1 is a cataloged member eligible for use of the POS terminal 8.

The ID number of the IC card 1, as stored in the ID number storage 11 of the IC card 1, is read by the card reader/writer 84 in the POS terminal 8 in a step S404 and is supplied to the processor 85 of the POS terminal 8. Next, the cataloged ID numbers are read from an ID number storage 60 in the personal information storage 88 in the POS terminal 8 in a step S405, and the ID number read from the IC card is correlated with the stored ID numbers to determine whether the ID number of the IC card is cataloged in the POS terminal 8 in a step S406 (col. 10, lines 36-67).

If it is found that the balance stored in the IC card 1 is less than the charge for the service or goods in a step S421, the user is alerted to the fact that the balance is short. It is checked again to determine whether the ID number of the IC card 1 is that of a cataloged member in a step S420. As a result, if the ID number is for a cataloged member, a message which urges the owner to indicate whether he/she desires a loan is displayed on a display 81 in the step S421 (col. 11, lines 63-col. 12, lines 4).

If the owner selects to obtain a loan on the POS register input unit 82 in the step S421, the charge is added to the sales storage 87 in the POS terminal 8 in a step S422 and the sum of the loan is stored in the loan amount storage 61. The data indicating the sum of a loan may be

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stored in both the POS terminal 8 and an IC card 1. The total charge may be loaned of the shortfall of a balance may be loaned (col. 12, lines 5-16).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 3 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan in view of Iijima (US 5,517,014). The teachings of Hogan have been discussed above.

Hogan lacks the teaching of contactless information card.

Iijima teaches the possible use of a noncontact IC card in place of a contacting IC card (col. 9, lines 56-61).

One of ordinary skill in the art would have readily recognized that to substitute a

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contacting information card with a contactless information card would have been beneficial since, with a contactless card, a user has faster access to the data stored on the card because the card need only be presented to the reading device as opposed to physically inserted and ejected from a terminal slot. Therefore, it would have been obvious, at the time the invention was made, to modify the teachings of Hogan with the aforementioned contactless information card as taught by Iijima.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan in view of Tateisi et al. (US 3,648,020) (hereinafter referred to as 'Tateisi'). The teachings of Hogan have been discussed above.

Hogan lacks the teaching of a money deposit terminal.

Tateisi teaches an automatic deposit-receiving and cash-dispensing machine featuring means for allowing a customer to deposit bills and/or coins to update the customer's account stored on a card 10 (col. 2, lines 18-30 and col. 4, lines 56-73).

One of ordinary skill in the art would have readily recognized that the advantage of providing a money deposit terminal to the invention of Hogan is that the user would have then been able to replenish the monetary amount of the card, thereby giving the user instant and flexible accessibility to the value of the card. Therefore, it would have been obvious, at the time the invention was made, to modify the teachings of Hogan with the money deposit terminal as taught by Tateisi.

Response to Arguments

8. Applicant's arguments received 5/28/02 have been fully considered but they are not persuasive. A processing means (in this case, the card issuer computer 303) processes a balance due as an indirect result of a purchase price exceeding a running balance on the card.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., compiles a balance due that represents the amount a transaction exceeds the cash value stored on the card) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Therefore, the examiner submits that the Hogan reference reads upon claims 1-19 of the instant invention.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

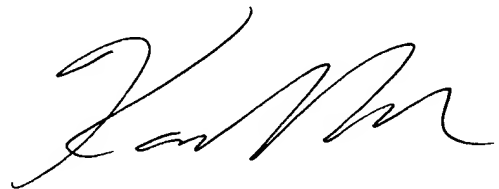
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamara A. Franklin whose telephone number is (703) 305-0128. The examiner can normally be reached on Monday through Friday 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703)308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Jamara A. Franklin
Examiner
Art Unit 2876

JAF
August 8, 2002

A handwritten signature in black ink, appearing to read 'Karl D. Frech', written in a cursive style.

KARL D. FRECH
PRIMARY EXAMINER